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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,024	06/25/2004	Masafumi Hashimoto	DK-US045129	2719

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EXAMINER	
TAKAOKA, DEAN O	
ART UNIT	PAPER NUMBER
2817	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/500,024	HASHIMOTO ET AL.	
	Examiner	Art Unit	
	DEAN O. TAKAOKA	2817	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 June 2004* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *6/25/04, 2/15/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Drawings

Figure 4 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8 – 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8 and 10 recites the limitation "said second unit" in the claims. There is insufficient antecedent basis for this limitation in the claim. The use of the word "said" suggests a previous listing of a "second unit" where no previous recitation can be found thus the claims are rejected under 35 U.S.C. 112, second paragraph.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Miyazaki et al. (US 6,151,228).

1. Miyazaki et al. shows a noise filter in an electric device for reducing noises from a predetermined noise generating source, said electric device comprising a first unit (5a) to which power is supplied from an original power source (1) and has said predetermined noise generating source (6), and a second unit (30) to which said power is supplied through a branch in said first unit (39), wherein power source lines for supplying said power from said original power source to said predetermined noise generating source and inter-unit lines for supplying said power from said branch to said second unit are wound around the same magnetic body (9).

2. Wherein the number of turns of said power source lines (L1, L2) and that of said inter-unit lines (L3) are set to be different from each other (Fig. 3).

3. Wherein the ratio of the number of turns of said inter-unit lines to the number of turns of said power source lines is set on the basis of the ratio of an impedance of said inter-unit lines to an impedance of said power source lines.

It is the position of the Examiner that the limitation of setting turns ratio based on impedance is a process limitation and is not given patentable weight. In a product claim only the final product in a product claim may be patentable. Miyazaki teaches

inductance of L1/L2 and L3 where L3 is less than 100uH c7, lns 26-32 where impedance is a function of parameters such as inductance thus the final product of Miyazaki inherently comprising an impedance ratio.

It should be noted that a "product-by-process" claim is directed to the product per se, no matter how such a product was made. It has been well established by the Courts that it is the patentability of the final product per se which must be determined in a "product-by-process" claim, and not the patentability of the process, and that an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product-by-process" form or not.

See *In re Hirao*, 190 USPQ 15 at 17 (footnote 3); *In re Brown*, 173 USPQ 685; *In re Luck*, 177 USPQ 523; *In re Fessman*, 180 USPQ 324, *In re Avery*, 186 USPQ 161; *In re Marosi et al.*, 218 USPQ 289; and in particular *In re Thorpe*, 227 USPQ 964. It should be noted that the applicant has the burden of proof in such cases, as the above case law makes clear.

4. Wherein the ratio of the number of turns of said inter-unit lines to the number of turns of said power source lines is set to be almost equal to the ratio of an impedance of said inter-unit lines to an impedance of said power source lines (where the term "almost equal" is broad where the limits are not defined by the claims, thus L3 almost equal to L1 or L3 and where turns in an inductor defines inductance where impedance is a function of parameters such as inductance).

5. Wherein said inter-unit lines are constructed of a plurality of lines, a total impedance of the plurality of lines is regarded as an impedance of said inter-unit lines,

and a bundle of electric lines obtained by bundling said plurality of lines is wound as said inter-unit lines (impedance and inductance discussed in the reasons for rejection of the claims above).

6. Wherein said inter-unit lines are constructed of a plurality of lines, and the ratio of the number of turns of said power source lines and the number of turns of said plurality of lines of said inter-unit lines is set on the basis of the ratio of respective impedances (where Miyazaki shows the final product where "setting" a ratio of turns based on impedance is drawn to a method claim as discussed with respect to claim 3 above).

7. Wherein the ratio between the number of turns of said power source lines and the number of turns of said plurality of lines of said inter-unit lines is set almost proportional to the ratio of said impedances (rejected for the same reasons as claims 3 and 6 above).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al. (US 6,053,002) in view of Madenokouji et al. (US 6,082,122).

1. Matsumoto et al. shows a noise filter in an electric device for reducing noises from a predetermined noise generating source, said electric device comprising a first

unit (1 – outdoor unit) to which power is supplied from an original power source (single phase 200V cable – Fig. 1) and has said predetermined noise generating source (8), and a second unit (2) to which said power is supplied through a branch in said first unit, but is silent with respect to a specific noise filter where the power source lines for supplying said power from said original power source to said predetermined noise generating source and inter-unit lines for supplying said power from said branch to said second unit are wound around the same magnetic body, where the noise filter of Matsumoto is generic.

Madenokouji et al. shows a most nearly identical electric device comprising a specific noise filter (100a).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted the specific noise filter disclosed by Madenokouji et al. for the generic noise filter disclosed by Matsumoto et al. Such a modification would have been a mere substitution of well-known art-recognized equivalent noise filters; further where both inventions are by the same Assignee thus suggesting the obviousness of the modification.

Allowable Subject Matter

Claims 8 – 10 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not teach or suggest the power source providing power to the indoor and outdoor unit where a branch of the outdoor unit provides power

to the indoor unit and where both power source lines and inter unit lines are wound around the magnetic body.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Butler shows a unitary control for air conditioner.

Sugiyama shows air-conditioning apparatus.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEAN O. TAKAOKA whose telephone number is (571)272-1772. The examiner can normally be reached on 9:00a - 5:30p Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pascal can be reached on (571) 272-1769. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

May 19, 2008
/Dean O Takaoka/
Primary Examiner, Art Unit 2817